

## II. General Remarks Concerning This Response

Claims 1, 3-10, 12, 14-26, 28-35, 37, 39-51, and 53 are currently pending in the present application. Claims 1, 3, 7, 8, 20, 22, 26, 28, 32, 33, 45, 47, 51, and 53 have been amended; no claims have been added; and claims 2, 11, 13, 27, 36, 38, and 52 have been canceled in this response. Reconsideration of the claims is respectfully requested.

## III. 35 U.S.C. § 103(a)—Obviousness

The Office action has rejected claims 1-53 under 35 U.S.C. § 103(a) as unpatentable over Grau et al., "Network Atlas Mapping Tool", U.S. Patent Number 5,910,803, filed 08/14/1996, issued 06/08/1999. This rejection is traversed.

Grau et al. was used as the basis for a broad obviousness rejection of all claims, particularly focusing on independent claim 1. In response, Applicant has amended all independent claims to include features that are not disclosed within Grau et al.. Thus, the applied prior art cannot be modified to reach the claimed features of the present invention.

### Examiner bears the burden of establishing a *prima facie* case of obviousness

The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case

of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

The applied prior art references clearly fail to disclose at least one feature of the present invention as recited within each independent claim, notwithstanding the obviousness arguments presented by the Office action, thereby rendering the applied prior art references incapable of being used as primary and secondary references as argued by the current rejection. Moreover, a hypothetical combination of the applied prior art references would also fail to reach the claimed invention of the present patent application. As should be recognized, because the applied prior art references in the rejections fail to disclose the claimed features against which the references were applied, and because the references fail to be combinable to produce these claimed features, the rejection fails to fulfill the requirements of a proper obviousness argument.

With respect to the claims of the present patent application, Applicant respectfully submits that it would not have been obvious for one having ordinary skill in the art to have used the applied prior art reference to reach the claimed invention. Hence, a rejection of the claims cannot be based upon the cited prior art to establish a *prima facie* case of obviousness. Therefore, a rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable in view of the cited prior art, and the claims are patentable over the

applied reference. Applicant respectfully requests the withdrawal of the rejection of the claims.

IV. Conclusion

It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a  
5 Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

10 DATE: September 27, 2006

Respectfully submitted,

  
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